

**Remarks/Arguments**

Claims 12, 31, 45-69, 77-87, 89-96 and 100-104 are pending. Claims 1-11, 3-30, 32-44, 70-76, 88, 97-99 and 105 have been cancelled without prejudice. Applicants reserve the right to pursue the subject matter of one or more of the cancelled claims in one or more related applications. Claims 31, 58-68, 77-84, 87 and 100 have been amended.

The subject matter encompassed by the amended claims is disclosed by the instant specification. Accordingly, no new matter has been added.

**Withdrawn Subject Matter**

The Examiner has stated that the claims have been examined as they relate only to SEQ ID NOs:1463 (antisense nucleic acid complimentary to the yphC gene), 12600 (yphC polypeptide) and 4228 (yphC nucleic acid encoding the yphC polypeptide<sup>1</sup>) (see the last two full paragraphs on page 2 of the Office Action mailed December 14, 2006).

Claim 77 recites the yphC polypeptide from *S. aureus* in addition to nucleic acids that encode yphC polypeptides from species other than *S. aureus* (*i.e.*, SEQ ID NOs:6154, 6592, 6872, 7273, 7857, 9420 and 9605). Claims 87 and 104 recite antisense nucleic acid molecules directed against *S. aureus* yphC in addition to SEQ ID NO:1463 (*i.e.*, SEQ ID NOs: 1390, 1845,

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<sup>1</sup> Applicants would like to clarify that SEQ ID NO:4228 encodes a polypeptide that is truncated by one amino acid as compared to SEQ ID NO:12600. This truncated polypeptide is SEQ ID NO:5283. SEQ ID NO:8502 encodes the full length SEQ ID NO:12600. Thus, SEQ ID NOs:5283 and 12600 differ by the addition of one C-terminal amino acid and SEQ ID NOs:4228 and 8501 differ by the addition of one coding codon and a termination codon.

2782 and 3283). Applicants contend it is proper to include all of the sequences identified *supra* in the present claims.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980) and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). According to the MPEP § 803.02, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

With respect to the various antisense nucleic acids recited in the claims, all are complimentary to at least a portion of SEQ ID NO:4228 (structural feature) and serve to decrease the expression of the polypeptide encoded by SEQ ID NO:4228 (functional feature). Thus, SEQ ID NOs: 1390, 1845, 2782, and 3283 should be examined with SEQ ID NO:1463 in the present application.

Even assuming, *en arguendo*, that there is no unity of invention, a reasonable number of nucleotide sequences can be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996). According to MPEP § 803.04, it has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction.

Applicants would like to note that the nucleic acids of SEQ ID NOs:6154, 6592, 6872, 7273, 7857, 8502, 9420, and 9605 encode yphC polypeptides corresponding to SEQ ID NOs:10251, 10689, 10969, 11370, 11955, 12600, 13518, and 13703, respectively. According to Table VIIA in the instant specification, SEQ ID NOs:10251, 10689, 10969, 11370, 11955, 13703 have at least 25% amino acid identity to SEQ ID NO:12600 (see the entries for LocusIDs EFA103174 and SAU100521 on pages 198 and 204, respectively, of the instant specification). As such, claim 67 encompasses the yphC polypeptides from species other than *S. aureus* that are claimed in claim 77. Applicants should not be required to cancel the additional SEQ ID NOs from claim 77.

#### **Objection to the Specification**

The Examiner has objected to the specification as allegedly containing embedded hyperlinks. Applicants would like to point out that the hyperlinks were deleted from pages 5, 76, 90 and 185 of the specification in the Amendment filed February 11, 2005. The hyperlinks on pages 88, 124, 125 and 127 are deleted herewith. Applicants request withdrawal of the Examiner's objection to the specification.

#### **Rejections Under 35 U.S.C. § 112**

Claims 57-69, 78-84 and 87 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 31 and 77-84 have been amended to more clearly point out that the allegedly unclear terms ("wherein said gene product", "wherein said nucleic acid

encoding said gene product" and "wherein said antisense nucleic acid" in claims 57, 77 and 78-84, respectively) refer to any of the claimed gene products or nucleic acids in the claims from which they depend.

Claims 31, 45-69, 77-84 and 101 have been rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner alleges that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors has possession of the claimed invention at the time of filing. Applicants respectfully disagree.

The Examiner contends that Applicants were not in possession of the utilization of antisense complementary to a gene product whose activity may be complemented by a gene product whose activity is inhibited by SEQ ID NO:1463 (see page 9, lines 1-3 of the Office Action mailed December 14, 2006). While Applicants do not agree with the Examiner's characterization, and solely in order to further prosecution, Applicants have amended the claims to delete references to a gene product whose activity may be complemented by a gene product whose activity is inhibited by SEQ ID NO:1463.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections under §112.

**Conclusion**

It is believed that the claims now pending are in condition for allowance. Early and favorable action by the Examiner is earnestly requested.

**Authorization**

The Commissioner is hereby authorized to charge \$1020.00 to deposit account 13-2755 to pay the fee under 37 C.F.R. §1.136(a) for an Extension of Time for three months. Additionally, the Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to deposit account 13-2755.

Respectfully submitted,

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